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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Karen Aviles

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EXAMINER

LONG, FONYA M

ART UNIT

PAPER NUMBER

3689

MAIL DATE

DELIVERY MODE

08/14/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/707,715	Applicant(s) AVILES ET AL.	
	Examiner FONYA LONG	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This communication is a Final Office Action rejection on the merits. Claims 1-20 have been amended. Claims 1-20 are currently pending and have been addressed below.

Response to Amendment

1. Applicant's amendments to the claims are sufficient to overcome the 101 rejection set forth in the previous office action.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 4-7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over DonationDepot.com (October 8, 2001) in view of MacFarlane et al. (7,014,104).

As per Claims 1, 2, 4-7, and 9, DonationDepot.com discloses a donation method, which is located in an online environment (via DonationDepot.com website) that is configured to facilitate:

providing access to information stored in the memory unit related to a plurality of government approved charities (Pages 1 and 3, discloses the system providing all

Art Unit: 3689

donors and all US 501(c) 3 non-profit organizations access, wherein a list of all registered non-profit organizations in the United States are provided to the donors) via a donation portal (defined as a site serving as a guide or point of entry to the World Wide Web and usually including a search engine or a collection of links to other sites arranged especially by topic in *Merriam-Webster Online Dictionary*. Retrieved July 17, 2008, from <http://www.merriamwebster.com/dictionary/portal>) (Pages 1-10, discloses providing a search engine on the website where a donor may search for a charity; and providing a hyperlink to obtain additional information about a charity via "Featured Charity");

searching for at least one of the charities in the formation stored in the memory unit (Page 1, discloses a donor capable of searching for a charity via "Find a Charity"); and

receiving donation information including recurring billing information (Page 2, discloses receiving automatic payroll deduction information (i.e. recurring billing)), donor information related to a donor (Page 5, discloses the donor providing personal information such as name, address, and phone), a donation amount and charity information (Page 6, discloses the donor providing the amount to be donated for a particular charity), and gift matching information (Pages 4 and 6, discloses the donor providing company gift matching information).

However, DonationDepot.com fails to explicitly disclose receiving employer information related to an employer of the donor; granting access rights to the employer to verify the donation information; and verifying the donation information.

Art Unit: 3689

MacFarlane et al. discloses a gift matching method with the concept of receiving employer information related to an employer of the donor (Abstract; Col. 2, Line 65-Col. 3, Line 10, discloses receiving transfer information comprising a receiver identifier, a matching party identifier (i.e. employer) and a first amount); if the processor determines that the received data from the employee stored in the memory unit indicates that the employer will gift match at least a portion of the donation amount, granting access rights to the employer to verify the donation information (Col. 11, Lines 7-28, discloses the employer (i.e. matching party) being granted access rights to approve the transfer of funds), and verifying, by the processor, the donation information on behalf of the employer by, at least: confirming that a payment from the employee for the donation amount was processed (Fig. 6A, discloses confirming a payment via confirming transfer has cleared); verifying that the charity is a government approved charity by, at least, searching at least one of: an Internal Revenue Service (IRS) database and a third-party database of government approved charities (Col. 9, Lines 11-35, discloses determining whether the charity qualifies in the United States as a charity), and generating a receipt for the employer by, at least: searching the memory unit for information related to gift matching forms specific to the employer, selecting a particular form based, at least in part, on the charity information stored in the memory unit, completing the selected gift matching form specific to the employer based on the donation information stored in the memory unit, and forwarding the completed form to the employer; and processing, after the verifying, a gift matching payment on behalf of the employer (Col. 8, Lines 50-67,

Art Unit: 3689

discloses providing a tax receipt to a matching party wherein matching forms are selected and completed by initiators).

Therefore, from the teaching of MacFarlane et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system for conducting donation of DonationDepot.com to include receiving employer information related to an employer of the donor; granting access rights to the employer to verify the donation information; and verifying the donation information as taught by MacFarlane et al. in order to aid in providing a convenient means to donate to charitable organizations electronically.

The Examiner notes, granting access rights to the employer to verify the donation information and verifying the donation information on behalf of the employer is dependent on the phrase "if the processor determines that the received data from the employee stored in the memory unit indicates that the employer will gift match at least a portion of the donation amount". This phrase is a conditional limitation. The noted step is not necessarily performed. Accordingly, once the positively recited steps are satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios. [See: *In re Johnston*, 77 USPQ2d 1788 (CA FC 2006); *Intel Corp. v. Int'l Trade Comm'n*, 20 USPQ2d 1161 (Fed. Cir. 1991); MPEP §2106 II C].

The Examiner notes, even though the combinations of DonationDepot.com in view of MacFarlane et al. discloses all the limitations of claims 1 and 7 as indicated supra, the "if the processor determines..." steps of claims 1 and 7 are conditional

Art Unit: 3689

limitations and are given little patentable weight. Methods are composed of actions, when you perform the actions of a method and do not select one of the alternatives or "if" steps, you are not performing any action under those alternatives. Accordingly, and as in the method itself, once a positively recited step is satisfied, the method as a whole is satisfied - regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios.

For examination purposes, the Examiner will take the broadest reasonable interpretation of the claims. Since the "if" statement is conditional and not necessarily performed, once the positively recited steps in the claims are satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios.

4. Claims 3, 8, and 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over DonationDepot.com (October 8, 2001) in view of MacFarlane et al. (7,014,104) and in further view of Chien et al. (US 2001/0054003).

As per Claims 3 and 8, the DonationDepot.com and MacFarlane combination discloses the claimed invention as applied to Claim 1, above. However, the combination fails to explicitly disclose loyalty points being used as a charitable donation.

Chien et al. discloses a system and method of using loyalty points with the concept of loyalty points being used as a charitable donation ([0012] discloses a user redeeming or converting loyalty points for charitable donations).

Therefore, from the teaching of Chien et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the

Art Unit: 3689

DonationDepot.com and MacFarlane combination to include loyalty points being used as a charitable donation as taught by Chien et al. in order to provide a non-monetary way for a donor to contribute to a desired charitable organization.

As per Claims 10-20, DonationDepot.com discloses a donation method, wherein said method comprising:

providing access to at least of a plurality of accessible government approved charities (Pages 1 and 3, discloses the system being providing for all donors and all US 501(c) 3 non-profit organizations, wherein a list of all registered non-profit organizations in the United States are provided to the donors) via a donation portal (defined as a site serving as a guide or point of entry to the World Wide Web and usually including a search engine or a collection of links to other sites arranged especially by topic in *Merriam-Webster Online Dictionary*. Retrieved July 17, 2008, from <http://www.merriamwebster.com/dictionary/portal>) (Pages 1-10, discloses providing a search engine on the website where a donor may search for a charity; and providing a hyperlink to obtain additional information about a charity via "Featured Charity") by providing at least one of: listing capabilities, searching capabilities, and selecting capabilities (Page 1, discloses a donor being able to search for a charity, or obtain a listing of charities); and

storing in the memory unit donation information for at least one of said charities, wherein donation information includes donor information related to a donor (Page 5, discloses the donor providing personal information such as name, address, and phone), donation amount and charity information (Page 6, discloses the donor providing the

Art Unit: 3689

amount to be donated to a particular charity), recurring billing information (Page 2, discloses receiving automatic payroll deduction information (i.e. recurring billing)), and gift matching information (Pages 4 and 6, discloses the donor providing company gift matching information).

However, DonationDepot.com fails to explicitly disclose receiving employer information related to an employer of the donor; granting access rights to the employer to verify the donation information; and verifying the donation information.

MacFarlane et al. discloses a gift matching method with the concept of receiving employer information related to an employer of the donor (Abstract; Col. 2, Line 65-Col. 3, Line 10, discloses receiving transfer information comprising a receiver identifier, a matching party identifier (i.e. employer) and a first amount); if the processor determines that the received data from the employee stored in the memory unit indicates that the employer will gift match at least a portion of the donation amount, granting access rights to the employer to verify the donation information (Col. 11, Lines 7-28, discloses the employer (i.e. matching party) being granted access rights to approve the transfer of funds) and verifying, by the processor, the donation information on behalf of the employer by, at least: confirming that a payment from the employee for the donation amount was processed (Fig. 6A, discloses confirming a payment via confirming transfer has cleared); verifying that the charity is a government approved charity by, at least, searching at least one of: an Internal Revenue Service (IRS) database and a third-party database of government approved charities (Col. 9, Lines 11-35, discloses determining whether the charity qualifies in the United States as a charity), and generating a receipt

Art Unit: 3689

for the employer by, at least: searching the memory unit for information related to gift matching forms specific to the employer, selecting a particular form based, at least in part, on the charity information stored in the memory unit, completing the selected gift matching form specific to the employer based on the donation information stored in the memory unit, and forwarding the completed form to the employer; and processing, after the verifying, a gift matching payment on behalf of the employer (Col. 8, Lines 50-67, discloses providing a tax receipt to a matching party wherein matching forms are selected and completed by initiators).

Therefore, from the teaching of MacFarlane et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system for conducting donation of DonationDepot.com to include receiving employer information related to an employer of the donor; granting access rights to the employer to verify the donation information; and verifying the donation information as taught by MacFarlane et al. in order to aid in providing a convenient means to donate to charitable organizations electronically.

Chien et al. discloses a system and method for using loyalty points with the concept of loyalty points being used as a charitable donation ([0012] discloses a user redeeming or converting loyalty points for charitable donations) wherein donation information is verified by communication with at least one third party, said third party including at least one of a financial institution, a charity, a loyalty point issuer, an employer, and a government entity authorized to approve charities ([0010-0011] discloses an account manager verifying loyalty point information via verifying that

Art Unit: 3689

sufficient credit is available on participant's financial transaction account and/or sufficient loyalty points are available in participant's loyalty account).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the DonationDepot.com and MacFarlane et al. combination to include loyalty points being used as a donation to a charitable organization and donation information is verified as taught by Chien et al. in order to provide a non-monetary way for a donor to contribute to a desired charitable organization.

The Examiner notes, granting access rights to the employer to verify the donation information and verifying the donation information on behalf of the employer is dependent on the phrase "if the processor determines that the received data from the employee stored in the memory unit indicates that the employer will gift match at least a portion of the donation amount". This phrase is a conditional limitation. The noted step is not necessarily performed. Accordingly, once the positively recited steps are satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios. [See: *In re Johnston*, 77 USPQ2d 1788 (CA FC 2006); *Intel Corp. v. Int'l Trade Comm'n*, 20 USPQ2d 1161 (Fed. Cir. 1991); MPEP §2106 II C].

The Examiner notes, even though the combinations of DonationDepot.com in view of MacFarlane et al. discloses all the limitations of claims 10 and 16 as indicated supra, the "if the processor determines..." steps of claims 10 and 16 are conditional limitations and are given little patentable weight. Methods are composed of actions,

Art Unit: 3689

when you perform the actions of a method and do not select one of the alternatives or "if " steps, you are not performing any action under those alternatives. Accordingly, and as in the method itself, once a positively recited step is satisfied, the method as a whole is satisfied - regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios.

For examination purposes, the Examiner will take the broadest reasonable interpretation of the claims. Since the "if" statement is conditional and not necessarily performed, once the positively recited steps in the claims are satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios.

Response to Arguments

5. Applicant's arguments filed May 08, 2009 have been fully considered but they are not persuasive.

As per Claims 1, 7, 10, and 16, Applicant argues that the DonationDepot.com and MacFarlane et al. combination fails to disclose "access rights are granted to the initiator's matcher, if stored information from the initiator indicates that the matcher will match a portion of the initiator's donation. Examiner respectfully disagrees. MacFarlane et al. discloses the employer (i.e. the initiator's matcher) being granted access rights to approve the transfer of funds in response to receiving an indication that the matcher will match the donation via determining the type of matching party after receiving a donation from the initiator (Col. 10, Line 55-Col. 11, Line 28).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FONYA LONG whose telephone number is (571)270-5096. The examiner can normally be reached on Mon-Thurs. 7:30am-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3689

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. L./

Examiner, Art Unit 3689

/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689